

## REMARKS

### A. Citation of Prior Art

Applicant filed an Information Disclosure Statement prior to the first office action under 37 C.F.R. 1.97 – 37 C.F.R. 1.99 having a certificate of mailing on August 2, 2004. Applicant disclosed under Reference Cite No. 15 of the PTO-1449 Form U.S. Patent No. 5,745,563. Applicant inadvertently and without deceptive intent, disclosed the incorrect U.S. Patent No. under Reference Cite No. 15. The correct U.S. Patent No. that Applicant intended to disclose under Reference Cite No. 15 is 5,746,563 to Steckler. Applicant respectfully requests the U.S. Patent Office consider U.S. Patent No. 5,746,563 during the examination of the subject pending patent application.

### B. Outstanding Action

Claims 1-18 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Avakian in view Mitchell or Kirkland.

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus in view Mitchell or Kirkland.

Claims 2, 3, 5, 7, 9-14, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus et al. in view of Mitchell or Kirkland and in further view of Nelson.

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus et al. in view of Mitchell or Kirkland and Nelson and further in view of Bergesen.

Claim 8 was objected to as being dependent upon a rejected base claim, but would be allowable

if rewritten in independent form including all of the limitations of base claim 2, and rewritten to avoid the rejections under 35 U.S.C. 112.

C. Status Of Claims

Claims 1-18 were pending in the application prior to the instant Amendment

Claims 1-18 are now pending.

D. Amendments To The Claims

The claim(s) has been amended in accordance with the enclosed marked up copy.

E. Allowance of Dependent Claim - Amendment Into Independent Form

Dependent claim 8 was indicated to be allowable, but was objected to as being dependent upon a rejected base claim. Independent claim 18 has been amended to contain all of the limitations indicated to be allowable subject matter. Applicant respectfully submits claim 18 is now in condition for allowance.

F. Pending Claims

35 U.S.C. 112 Rejections

Claims 1-18 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1-18 have been amended to overcome the rejection under 35 U.S.C. 112.

### 35 U.S.C. 103(a) Obviousness Rejections

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Avakian in view Mitchell or Kirkland. Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus in view Mitchell or Kirkland. Claims 2, 3, 5, 7, 9-14, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus et al. in view of Mitchell or Kirkland and in further view of Nelson.

The U.S. Patent Office recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness. The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

The Applicant respectfully requests amended claims 1, 2 and 17 overcome the rejection under 35 U.S.C. 103(a).

### Lack of Basis In The Art for Combining Or Modifying Cited References

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987), stated:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933'(Fed. Cir. 1984).

The patent to Avakian teaches a cross bar 24 secured to the load bar 18. (Column 7, Lines 61-63). Avakian does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide the cross bar 24 with horizontal movement along the load bar 18. In addition, Avakian does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide a vertical telescoping shaft.

The patent to Mitchell teaches a portable crane wherein a workman releases the lock nut 16 and turns the hub 12 and the rod 11 by means of the arms 14 until the upper contact plate is pressed against the ceiling by means of the pipe 28 which holds the mast of the crane vertical. (Column 3, Lines 17-22). Mitchell does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide the base plate 1 with any horizontal movement along the foot boards 5. In addition, Mitchell does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide a horizontal telescoping shaft.

The patent to Kirkland teaches a davit assembly 11 removably secured to a floor by a base mounting member 12 and to a ceiling or other overhead horizontal surface by an upper mounting member 29. (Column 4, Lines 7 – 10). Kirkland further teaches upon the torque nut 22 reaching its maximum height on screw jack 16, limited by stop 20, davit assembly 11 is locked in place by virtue of being biased against the floor at its lower end and against the ceiling or overhead surface at its upper end. (Column 4, Lines 36-40). Kirkland does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide the base mounting member 12 with any horizontal movement along the floor. In addition, Kirkland does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide a horizontal telescoping shaft.

The patent to Andrus teaches a main support plate 104 have a hole 110 mounted to leg 102 immediately adjacent bracket 109 so that legs 101 and 102 provide adequate support for equipment

mounted to plate 104. (Column 3, Lines 34 – 40). Andrus further teaches extension 102A being set at a preselected position relative to leg 102 by selecting one of a number of holes on extension 102A using a bolt 106, nut 107 and washer 111. (Column 3, Lines 1 - 4). Andrus does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide the base mounting member 12 with any horizontal movement along the floor. In addition, Andrus does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide a vertical telescoping shaft. Furthermore, Andrus does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide a horizontal expander or a vertical expander.

The patent to Nelson teaches a elongating subassembly 28 including an upper sleeve or elongating member 35 which has a bolt receiving hole 36 passing through it and is hollowly constructed to slidably receive the upper portion of the column member 27. (Column 3, Lines 1 – 5). By tightening the wing bolt 39 the upper sleeve 35 can be fixed in position on the member 27 to fixedly maintain the relative position between the elongating member 35 and the column member 27 at selected points along the column member 27. (Column 3, Lines 10 – 15). Nelson further teaches a additional stability obtained by loosely securing the column member 27 to a truck wall 51 by a strap 52. (Column 3, Lines 28 – 30). Nelson further teaches a base means 23 including a base block 88 and a base plate 89 security affixed thereto. (Column 4, Lines 23 – 25). Nelson does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide the base block 88 and the base plate 89 with any horizontal movement along the floor. In addition, Nelson does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide a horizontal expander or a vertical expander.

The patent to Bergesen teaches the lower end of the mast 5 seated within one section of a tubular T-joint 8, invertedly arranged with its horizontal section 9 slidably carried on a horizontally

disposed rod 10, the horizontal section of the joint and the rod also have openings 11 formed transversely therein for receiving a pin 12 whereby to secure the joint in longitudinally adjusted position with respect to said rod. The rod 10 extends through a window or other suitable opening indicated generally at 13 and disposed above the sill 14 thereof, the inner and outer ends of the rod carry clamping members 15, slidably carried on the rod 10 and secured in adjusted position thereon by set screws 16. Bergesen does not provide any teaching, suggestion or incentive to one of ordinary skill in the art to provide a horizontal expander or a vertical expander.

As set forth in claim 1, applicant has invented an improved hoist to reposition a load between a vehicle compartment and an external surface. A horizontal channel of the base is slidably receives a horizontal telescoping shaft for adjusting the position of the base relative to each of the distal ends of the horizontal telescoping shaft to position the base at the desired location within the vehicle compartment. A horizontal expander is located between the first and second distal ends of the horizontal telescoping shaft for applying a horizontal engaging force between the first and second distal ends and the opposed vertical surfaces of the vehicle compartment for horizontally stabilizing the base within the vehicle compartment. A vertical telescoping shaft has a distal end with a vertical expander located between the base surface and the distal end of the vertical telescoping shaft for applying a vertical engaging force between the lower and upper horizontal surface of the vehicle compartment for vertically stabilizing the base within the vehicle compartment.

As set forth in claim 2, applicant has invented an improved hoist to reposition a load between a vehicle compartment and an external surface. A horizontal expander is located between the first and second distal ends of the horizontal telescoping shaft for applying a horizontal engaging force between the first and second distal ends and the opposed vertical surfaces of the vehicle compartment for horizontally stabilizing the base within the vehicle compartment. A vertical telescoping shaft has a

distal end with a vertical expander located between the base surface and the distal end of the vertical telescoping shaft for applying a vertical engaging force between the lower and upper horizontal surface of the vehicle compartment for vertically stabilizing the base within the vehicle compartment.

As set forth in claim 17, applicant has invented an improved hoist to reposition a load between an automobile trunk and an external surface. A horizontal jack screw is located between the first and second distal ends of the horizontal telescoping shaft for applying a horizontal engaging force between the first and second distal ends and the opposed vertical surfaces of the vehicle compartment for horizontally stabilizing the base within the automobile trunk. A vertical telescoping shaft has a distal end with a vertical jack screw located between the base surface and the distal end of the vertical telescoping shaft for applying a vertical engaging force between the lower and upper horizontal surface of the automobile trunk for vertically stabilizing the base within the vehicle compartment.

The combined teachings of Avakian, Mitchell, Kirkland, Andrus et al, Nelson and Bergesen do not provide any teaching, suggestion or incentive to produce the applicant's invention in claims 1, 2 or 17. In addition, Avakian, Mitchell, Kirkland Andrus et al, Nelson and Bergesen do not suggests the desirability of combination of the applicant's invention in claims 1, 2 and 17.

As such, applicant respectfully submits there is no basis in the art for combining or modifying the cited references to reject claims 1, 2 and 17 under 35 U.S.C. 103(a).

#### **Applicant's Remaining Claims**

The applicant respectfully submits that the rejection of claims 3-16 under 35 U.S.C. 103(a) as being unpatentable over Avakian, Mitchell, Kirkland Andrus et al, Nelson and Bergesen have been

overcome due to the above arguments. Accordingly applicant respectfully submits the rejection of claims 3-16 that include the same limitations as claim 1 are similarly allowable over Avakian, Mitchell, Kirkland Andrus et al, Nelson and Bergesen.

G. Examiners Notice of References Cited

The prior art made of record but not relied upon has been reviewed and appears to be less pertinent to the claimed subject matter than the references cited by the Examiner. The remaining references do not teach nor suggest the structure set forth in the proposed claim.

H. Request For Extension of Time

Enclosed is a Request for Extension of Time to respond to the outstanding office action. Please charge Deposit Account No. 06-2120 for the fees for the Extension of Time.

I. Precautionary Request for an Extension of Time

In the event the present filing is not timely filed, applicant request an Extension of Time for an appropriate period of time. Please charge Deposit Account No. 06-2120 for the fees for any Extension of Time.

J. Additional Fees

Please charge Deposit Account No. 06-2120 for the fees for any additional claims, an Extension of Time, Citation of Prior Art, Petitions, Terminal Disclaimers or any other fee arising out of this correspondence.

Applicant verily believes that all claims are now in condition for allowance and favorable action



is respectfully requested. The undersigned attorney of record cordially invites any telephonic communications from the Examiner that may assist the examiner in the examination and to expedite the allowance and issuance of Letters Patent on the subject invention.

Respectfully submitted,

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Deposit Account

Please charge our account any deficiency in fees or credit any over payment arising out of this correspondence to Deposit Account No. 06-2120.

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It is hereby certified that the foregoing correspondence and fee is being placed in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450 and mailed by first class mail, postage prepaid, this 31<sup>st</sup> day of October, 2005.

